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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,130	09/26/2003	Christopher W. Ramirez	DC-05161	6077

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EXAMINER
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LE, NANCY LOAN T

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/672,130

Applicant(s)

RAMIREZ ET AL.

Examiner

NANCY LOAN T. LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 2-3, 5, 7-8, 11-13, 15-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>27 February 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

Claims 1-20 have been examined.

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference numbers not mentioned in the description: *numerals 100-400 in figures 1-4. These reference numerals 100-400 points to nowhere; there is no description for those reference numerals as well as object 'A'*. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on February 27, 2004 was filed after the mailing date of the application (application no. 10/672,130) filed on September 26, 2003. The submission is in compliance with the provisions of 37 CFR 1.97 for all cited references, except for a *foreign patent EP 0 921 487 A1, dated September 6, 1999* (reason: a

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certified copy of this foreign patent is not included at time of submission). Accordingly, the information disclosure statement for all cited references excluding the above-mentioned foreign patent is being considered by the examiner.

### ***Claim Objections***

3. Claims 2-3, 5, 7-8, 11-13, 15-17 are objected to because of the following informalities: *a colon ':'* should be used in place of a semi-colon ';' following the words 'further comprising' for *claims 2, 18*, and following the word 'wherein' for *claim 8*; there is no need to use the semi-colon ';' following the word 'wherein' for *claims 3, 5, 13, 15*; *a colon ':'* is needed following the words 'comprising' for *claims 7, 12, 17*, and following the words 'configured to' for *claim 11*. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bueche, U.S. Patent No. 6,834,269, published on December 21, 2004.

As per claim 1, Bueche discloses a method for enabling remote restoration of a purchase verification, comprising:

- obtaining a value that uniquely identifies an information handling system (col. 10, lines 3-14);
- obtaining a promotion code value that identifies a benefit (col. 9, lines 13-40);
- linking the value that uniquely identifies the information handling system with the promotion code value for the information handling system (col. 10, lines 5-9);
- during remote restoration, obtaining the promotion code value for the information handling system by providing the value that uniquely identifies the information handling system (col. 10, lines 3-14); and,
- providing the promotion code value to the information handling system to re-enable the benefit (col. 10, lines 15-24).

As per claim 2, Bueche discloses a method of claim 1, further comprising:

- installing application software in an information handling system memory when the information handling system is assembled at a manufacturing facility (col. 5, lines 13-34); and
- linking any promotion code values with the value that uniquely identifies the information handling system within an order management system (col. 10, lines 5-9).

As per claims 3, 8, 13, and 18, Bueche discloses a method of claims 1, 7, 11, and 17, respectively, wherein:

- the promotion code value includes a system specific key that enables a benefit (Table 1; col. 7, lines 35-57; col. 10, lines 3-19).

As per claim 4, Bueche discloses a method of claim 3 wherein:

- the benefit was erased prior to registration of the benefit (col. 6, lines 32-37); and,
- the method includes placing the keys and software back onto the information handling system (col. 5, lines 37-67; col. 6, lines 38-43; col. 10, lines 20-24).

As per claims 5, 9, 15, and 19, Bueche discloses a method of claims 1, 7, 11, and 17, respectively, wherein:

- the value that uniquely identifies an information handling system is a service tag (col. 8, lines 52-67).

As per claim 6, Bueche discloses a method of claim 1 further comprising:

- determining whether any promotion code value or benefit is present on the information handling system during the remote restoration; and
- comparing an expected promotion code value and expected benefit to any promotion code value or benefit stored on the information handling system to determine which promotion code value and benefit to restore to the information handling system (col. 10, lines 56-67; col. 11, lines 1-67).

As per claim 7, Bueche discloses a process for remote creation of a system specific key for a benefit purchased post point-of-sale comprising:

- obtaining a value that uniquely identifies an information handling system (col. 10, lines 3-14);
- obtaining a promotion code value that identifies the benefit (col. 9, lines 13-40);
- linking the value that uniquely identifies the information handling system with the product code value (col. 10, lines 5-9); and,
- creating the system specific key for the benefit purchased post point of sale based upon the value that uniquely identifies the information handling (col. 10, lines 15-24); and,

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- providing the promotion code value to the information handling system to enable benefit (col. 10, lines 15-24).

As per claim 10, Bueche discloses a process/method of claim 7 further comprising:

- determining whether any promotion code value or benefit is present on the information handling system during the remote creation; and
- comparing an expected promotion code value and expected benefit to any promotion code value or benefit stored on the information handling system to determine which promotion code value and benefit to provide to the information handling system (col. 10, lines 56-67; col. 11, lines 1-67).

As per claim 11, Bueche discloses a system for enabling remote restoration of a purchase verification, comprising:

- a restore module, the restore module being configured to:
  - ◆ obtain a value that uniquely identifies an information handling system (col. 10, lines 3-14);
  - ◆ obtain a promotion code value that identifies a benefit (col. 9, lines 13-40);
  - ◆ link the value that uniquely identifies an information handling system with the product code value for the information handling system (col. 10, lines 5-9);
  - ◆ during remote restoration, obtain the promotion code value for the information handling system by providing the value that uniquely identifies the information handling system (col. 10, lines 3-14); and,
  - ◆ provide the promotion code value to the information handling system to re-enable benefit (col. 10, lines 15-24).

As per claim 12, Bueche discloses a system of claim 11 further comprising:

- an install module, the install module installing application software on an information handling system memory when the information handling system is assembled at a manufacturing facility (col. 5, lines 13-34); and,

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- a link module, the link module linking any promotion code values with the value that uniquely identifies the information handling system within an order management system (col. 10, lines 5-9).

As per claim 14, Bueche discloses a system of claim 13 wherein:

- the benefit was erased prior to registration of the benefit (col. 6, lines 32-37); and,
- the restore module includes instructions for placing the keys and software back onto the information handling system (col. 5, lines 37-67; col. 6, lines 38-43; col. 10, lines 20-24).

As per claim 16, Bueche discloses a system of claim 11 further comprising:

- a determining module, the determining module determining whether any promotion code value or benefit is present on the information handling system during the remote restoration; and
- a comparing module, the comparing module comparing an expected promotion code value and expected benefit to any promotion code value or benefit stored on the information handling system to determine which promotion code value and benefit to restore to the information handling system (col. 10, lines 56-67; col. 11, lines 1-67).

As per claim 17, Bueche discloses a system for remote creation of a system specific key for a benefit purchased post point-of-sale comprising:

- a restore module, the restore module configured to:
  - ◆ obtain a value that uniquely identifies an information handling system (col. 10, lines 3-14);
  - ◆ obtain a promotion code value that identifies the benefit (col. 9, lines 13-40);
  - ◆ link the value that uniquely identifies the information handling system with the product code value (col. 10, lines 5-9); and,



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- ◆ create the system specific key for the benefit purchased post point-of-sale based upon the value that uniquely identifies the information handling (col. 10, lines 15-24); and,
- ◆ provide the promotion code value to the information handling system to enable benefit (col. 10, lines 15-24).

As per claim 20, Bueche discloses a system of claim 17, the restore module is further configured to:

- determine whether any promotion code value or benefit is present on the information handling system during the remote creation; and
- compare an expected promotion code value and expected benefit to any promotion code value or benefit stored on the information handling system to determine which promotion code value and benefit to provide to the information handling system (col. 10, lines 56-67; col. 11, lines 1-67).

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Factory-installed software purchase verification key, Charles L. Bueche, U.S. Patent No. 6,834,269 B1, published on December 21, 2004.
- Method and system for redeeming product marketing rebates, Quinlan et al., U.S. Patent Publication No. 2004/0215514 A1, published on October 28, 2004.
- Method and system for redeeming product marketing rebates, Quinlan et al., U.S. Patent Publication No. 2002/0161641 A1, published on October 31, 2002.
- System and method for tracking authenticated items, Tommy L. Davis, JR., U.S. Patent Publication No. 2004/0088231 A1, published on May 6, 2004.
- Method and system for identifying and obtaining computer software from a remote computer, Philip E. Fawcett, U.S. Patent No. 6,327,617, published on December 4, 2001.

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- System and method for identification and streamlined access to on-line services, David S. Springer, U.S. Patent No. 6,321,262 B1, published on November 20, 2001.
- Graphical user interface system and method for automatically updating software products on a client computer system, Cheng et al., U.S. Patent No. 6,763,403 B2, published on July 13, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is (703) 305-0549. The examiner can normally be reached on Monday-Thursday, 6am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES P. TRAMMELL can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, for official/regular communication. For informal/draft communication, the fax number is 703-302-3376 (rightfax).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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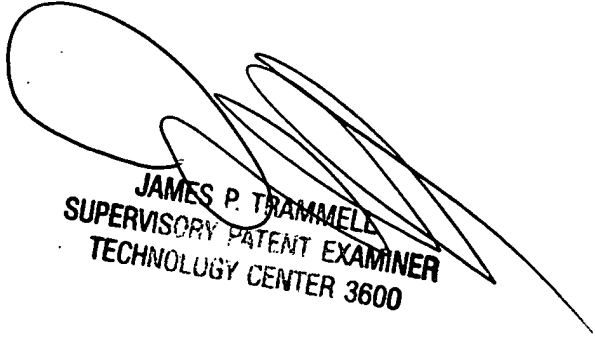
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Hand delivered responses should be brought to **Receptionist** whose telephone number is **(703) 305-3900** located in Crystal Park 5, at 2451 Crystal Drive, Arlington, Virginia 22202, seventh floor.

NLL  
2/22/2005



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